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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,095	09/18/2003	Moshe Meller	03515/LH	2247
1933	7590	06/29/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708			ROBERT, EDUARDO C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/667,095	MELLER, MOSHE
	Examiner Eduardo C. Robert	Art Unit 3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 26 April 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-32 is/are pending in the application.  
 4a) Of the above claim(s) 18, 19 and 21-28 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-17, 20, 30 and 31 is/are rejected.  
 7) Claim(s) 32 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 18 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/18/03; 10/27/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION*****Election/Restrictions***

Applicant's election without traverse of Species I (Figures 1-4) in the reply filed on April 26, 2005 is acknowledged.

It is acknowledged applicant's believe that claims 1-17, 20, and 29-32 read on the elected Species. The examiner agrees with applicant.

Also, it is acknowledged applicant's believe that claims 1, 2, 14, 17, 20, and 29-31 are generic. It is noted that the examiner agrees with applicant, except for that claim 14 and 20 are generic. Claims 14 and 20 are not generic claims because non-elected Species III (Figure 6) does not have a rotation preventing device as required in claim 14 or the specific of claim 20.

Claims 18, 19, and 21-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 26, 2005.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-17, 20 and 29 are rejected under 35 U.S.C. 101 because they are drawn to non-statutory subject matter. In claim 1, lines 8-9, applicant positively recites part of a human, i.e. "said container being held against the surface of the bone at a down site". Thus claims 1-17, 20 and 29 include a human within their scope and are non-statutory.

A claim directed to or including within its scope a human is not considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution. *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

***Claim Objections***

Claims 1-17, 20 and 29 are objected to because of the following informalities:

There exists an inconsistency between the language of claim 1 and that of the claim 29 dependent thereon, thus making the scope of the claims unclear. In claim 1, applicant recites "A bone grafter attachment unit" with the hand piece being only functionally recited, i.e. "for removing and collecting bone fragments from a bone using a surgical rotational hand piece", thus indicating that the claims are directed to the subcombination, "bone grafter attachment unit". However, in claim 29, applicant positively recites the hand piece as part of the invention, i.e. "wherein the hand piece has a reverse rotational motion ...", thus indicating that the combination, attachment unit and hand piece, is being claimed. As such, it is unclear whether applicant intends to claim the subcombination or combination. Applicant is hereby required to indicate to which, combination or subcombination, the claims are intended to be directed, and amend the claim such that the language thereof is consistent with this intent. For examination purposes claims 1-17, 20 and 29 will be considered as being drawn to the sub-combination, attachment unit.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 8, 14, 17, 20, and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Fox (U.S. Patent No. 6,071,284, cited by applicant).

Fox discloses a bone grafting attachment unit comprising a rotatable drill bit having a shank engageable with a hand piece and a cutting member which includes a flute (see Figures 3a and 3b). The unit further comprises a container (see Figures 3a and 3b) having an opening through which the cutting member passes. The unit must include a fixing device to keep the container from rotating with the drill bit. The unit also has an annular bottom part which includes the opening and it is attached to the inner sleeve (see Figures 3a and 3b). The drill bit is movable relative to the container (see Figures 3a and 3b). The container has an inner sleeve unit 110 having an opening at one end and an outer sleeve 120 surrounding at least a part of the inner unit (see Figure 3a and 3b). The sleeves are selectively fixed, they are threaded. The unit of Fox is used including the steps of providing the unit, urging the container against a surface of a bone; operating a hand piece so to rotate the drill bit and pressing the drill in direction of the bone; holding the container; and passing bone fragments through the opening of the container (see Figure 3a and 3b). With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Fox which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA

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1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Allowable Subject Matter***

Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 571-273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.